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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/693,748	10/24/2003	Dennis W. Waggamon	125426-1089	2451

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EXAMINER

HOLLOWAY III, EDWIN C

ART UNIT	PAPER NUMBER
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2612

MAIL DATE	DELIVERY MODE
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07/12/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/693,748

Applicant(s)

WAGGAMON ET AL.

Examiner

Edwin C. Holloway, III

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 April 2007.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 6 and 7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 6 and 7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

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EXAMINER'S RESPONSE

1. In response to applicant's amendment filed 4-13-07, the preliminary amendment has been entered. The examiner has considered the new presentation of claims and applicant's arguments in view of the disclosure and the present state of the prior art. And it is the examiner's opinion that the claims are unpatentable for the reasons set forth in this Office action:

Specification

2. The disclosure is objected to because of the following informalities: The continuing data should be updated to include both patent numbers 6049289 and 6667684 for the two parent applications.

Appropriate correction is required.

Claim Objections

3. Claim 6 is objected to because of the following informalities: The preamble of claim 6 identifies the claim as directed to a transmitter, but the body of the claim includes limitations of a receiver that are not part of the transmitter.

It is suggested that a system be recited in the preamble.

Appropriate correction is required.

Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or

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improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 6-7 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1-4 of U.S. Patent No. 6049289. Although the conflicting claims are not identical, they are not patentably distinct from each other because Claims 6-7 generally broader than the claims in the patent. Broader claims in a later application constitute obvious double patenting of narrow claims in an issued patent. See *In re Van Ornum and Stang*, 214, USPQ 761, 766, and 767 (CCPA) (the court sustained an obvious double patenting rejection of generic claims in a continuation application over

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narrower species claims in an issued patent); *In re Vogel*, 164 USPQ 619, 622, and 623 (CCPA 1970) (generic application claim specifying "meat" is obvious double patenting of narrow patent claim specifying "pork").

Regarding claim 6, the transmitter limitations are found in claim 1 lines 1-15 and the receiver limitations in claim 1 lines 16-36 of 6049289.

Regarding claim 7, the transmitter limitations are found in claim 1 lines 1-15 and the receiver limitations in claim 1 lines 16-36 of 6049289.

6. Claims 6-7 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6667684. Although the conflicting claims are not identical, they are not patentably distinct from each other because Claims 6-7 generally broader than the claims in the patent. Broader claims in a later application constitute obvious double patenting of narrow claims in an issued patent. See *In re Van Ornum and Stang*, 214, USPQ 761, 766, and 767 (CCPA) (the court sustained an obvious double patenting rejection of generic claims in a continuation application over narrower species claims in an issued patent); *In re Vogel*, 164 USPQ 619, 622, and 623 (CCPA 1970) (generic application claim specifying "meat" is obvious double patenting of narrow patent

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claim specifying "pork").

Regarding claim 6, the transmitter limitations are found in claim 1 lines 4-18 and the receiver limitations in claim 1 lines 19-39 of 6667684.

Regarding claim 7, the transmitter limitations are found in claim 1 lines 4-18 and the receiver limitations in claim 1 lines 19-39 of ~~6~~6667684.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this

Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9. Claims 6-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Heitschel '118 (US 475011) or Heitschel '986

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(US00RE37986E) in combination with Brewer'904 (US 5686904).

Heitschel'118 discloses an analogous art GDO receiver with random access memory (RAM) in CPU 44 for automatically and randomly storing transmitter codes. If all memory location have been used, storing a new code will erase or overwrite at least one old code. See col. 4 lines 58-68. Heitschel '968 is a reissue of Heitschel '118 and includes selecting a memory address to be erased in all location are used in claim 24.

Bruwer'904 discloses an analogous art secure self learning system with reference to garage door opening in col. 1 lines 22-23 and reference to Heitschel '118 for code learning in col. 2 lines 22-41. A transmitters designated for a manufacturer (manufacturer master key) and having a unique code (unique serial number 62) and multibit hopping codes (32 bit encoded string 70) is included in fig. 2 and col. 14 line 19 - col. 16 lien 20. A receiver with memory 84 and processor 100 for learning transmitter information in described in co. 19 line 37 - col. 20 line 36.

Regarding claims 6-7, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included in Heitschel'118 or Heitschel '986 the hopping codes, unique codes and manufacturer designation of Brewer '904 to prevent unauthorized control and increased security of a

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garage door operation.

10. Claims 6-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Heitschel '118 (US 475011) or Heitschel '986 (US00RE37986E) in combination with Issa (US 5798711)

Heitschel'118 discloses an analogous art GDO receiver with random access memory (RAM) in CPU 44 for automatically and randomly storing transmitter codes. If all memory location have been used, storing a new code will erase or overwrite at least one old code. See col. 4 lines 58-68. Heitschel '968 is a reissue of Heitschel '118 and includes selecting a memory address to be erased in all location are used in claim 24.

Issa discloses an analogous art hopping code learning system with reference to garage door opening in col. 2 lines 550-51. A transmitters designated for a manufacturer (manufacturer code and algorithm in col. 16 lines 6-9 and 61-63) and having a unique code (serial no. in col. 15, line 49, unique code in col. 22 line 30) and multibit hopping codes (hopping bits in col. 8 line 28) is shown in fig. 1. A receiver with memory 37 and processor 35 for learning transmitter information in described in co. 24 line 16 - col. 25 line 26. Overwriting old codes is disclosed in col. 24 line 30.

Regarding claims 6-7, it would have been obvious to one of ordinary skill in the art at the time the invention was made to

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have included in Heitschel '118 or Heitschel '986 the hopping codes, unique codes and manufacturer designation of Issa to prevent unauthorized control and increased security of a garage door operation. Alternatively, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included in Issa the random storage and overwrite of Heitschel '118 or Heitschel '986 suggested by the overwrite of Issa to delete obsolete or lost transmitters.

11. Claims 6-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Soenen (US 6046680) in combination with Issa (US 5798711).

Soenen discloses an analogous art GDO receiver with random access memory 36 in MPU 30 for automatically and randomly storing transmitter codes. Up to four codes can be stored. If all memory location have been used, the next code will overwrite a code. See col. 1 lines 20-43 and col. 14 lines 29-36.

Issa discloses an analogous art hopping code learning system with reference to garage door opening in col. 2 lines 550-51. A transmitters designated for a manufacturer (manufacturer code and algorithm in col. 16 lines 6-9 and 61-63) and having a unique code (serial no. in col. 15, line 49, unique code in col. 22 line 30) and multibit hopping codes (hopping bits in col. 8 line 28) is shown in fig. 1. A receiver with

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memory 37 and processor 35 for learning transmitter information in described in co. 24 line 16 - col. 25 line 26. Overwriting old codes is disclosed in col. 24 line 30.

Regarding claims 6-7, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included in Soenen the hopping codes, unique codes and manufacturer designation of Issa to prevent unauthorized control and increased security of a garage door operation.

Alternatively, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included in Issa the random storage and overwrite of Soenen suggested by the overwrite of Issa to delete obsolete or lost transmitters.

Response to Arguments

12. Applicant's arguments with respect to claims 6-7 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Farris (US006025785A) discloses a learning receiver with hopping codes.

CONTACT INFORMATION

Information regarding the status of an application may be

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obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact an Electronic Business Center (EBC) representatives at 571-272-4100 or toll free at 1-866-217-9197 between the hours of 6 a.m. and midnight Monday through Friday EST, or by e-mail at ebc@uspto.gov. The Patent EBC is a complete customer service center that supports all Patent e-business products and service applications. Additional information is available on the Patent EBC Web site at <http://www.uspto.gov/ebc/index.html>.


Any inquiry of a general nature should be directed to the Technology Center 2600 receptionist at (571) 272-2600.

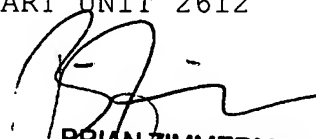
Facsimile submissions may be sent via central fax number 571-273-8300 to customer service for entry by technical support staff. Questions related to the operation of the facsimile system should be directed to the Electronic Business Center.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edwin C. Holloway, III whose telephone number is (571) 272-3058. The examiner can normally be reached on M-F (8:30-5:00). If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wendy Garber can be reached on (571) 272-7308.

EH
7/8/07


EDWIN C. HOLLOWAY, III
PRIMARY EXAMINER
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